

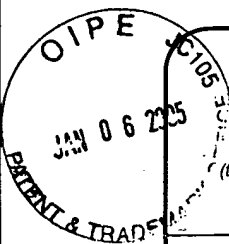
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PTO/SB/21 (02-04)

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/809,068
Filing Date	March 25, 2004
First Named Inventor	Mutel
Art Unit	1625
Examiner Name	Aulakh, Charanjit
Attorney Docket Number	20856 US2

## ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<div>Remarks</div>		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Kimberly J. Prior
Signature	<i>Kimberly J. Prior</i>
Date	01/04/2005

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Kimberly J. Prior
Signature	<i>Kimberly J. Prior</i>
Date	01/04/2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,068	03/25/2004	Vincent Mutel	20856US2	6997

151 7590 10/21/2004  
HOFFMANN-LA ROCHE INC.  
PATENT LAW DEPARTMENT  
340 KINGSLAND STREET  
NUTLEY, NJ 07110



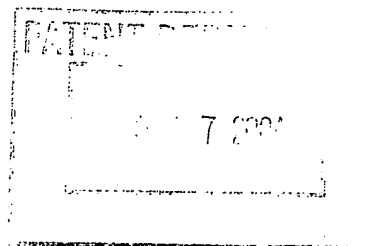
EXAMINER AULAKH, CHARANJIT	
ART UNIT 1625	PAPER NUMBER

DATE MAILED: 10/21/2004

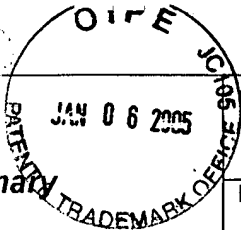
Please find below and/or attached an Office communication concerning this application or proceeding.

RESPONSE DUE: <u>January 21, 2005</u>
STATUTORY PERIOD EXPIRES: <u>April 21, 2005</u>

bak



**Office Action Summary**



Application No.

10/809,068

Applicant(s)

MUTEL ET AL

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/093,790.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Claims 1-11 are pending in the application.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 recites the limitation "method" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

4. Claims 3-7 recite the limitation "composition" in claim 2. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher ( U.S. Patent 3,701,780, cited on applicants form 1449 ).

Fisher discloses Imidazopyridines having anthelmintic and fungicidal activity and pharmaceutical compositions containing these compounds. The pharmaceutical compositions containing exemplified compounds of examples 3, 7 and 8 disclosed by Fisher anticipate the instant claims when A represents a heteroaryl group in the instant compounds of formula I.

6. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Andreani ( Eur. J. Med. Chem., cited on applicants form 1449 ).

Andreani discloses cardiotonic activity ( pharmaceutical utility ) of aryl- or pyridyl-substituted fused imidazoles. The compounds 3a, 3b and 3c ( see page 339 and table

Art Unit: 1625

111 on page 342 ) disclosed by Andreani anticipate the instant claims when A represents phenyl or heteroaryl group in the instant compounds of formula I.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue ( JP 11-116481, cited on applicants form 1449 ).

Inoue discloses pharmaceutical utility of Imidazolepyridine derivatives for treating autoimmune, viral and bacterial diseases. The compounds disclosed on pages 9-12 by Inoue anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

8. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Raj ( IN 179790 ).

Raj discloses novel 2-substituted imidazopyridines and their pharmaceutical utility for having antifertility activity. The compounds disclosed in examples 3 and 4 ( see pages 4 and 5 ) anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Raj ( IN 179788 ).

Raj discloses novel 2-substituted imidazopyridines and their pharmaceutical utility for having antifertility activity. The compounds disclosed in examples 1-4 ( see pages 4-6 ) anticipate the instant claims when A represents aryl group in the instant compounds of formula I.

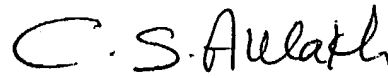
***Allowable Subject Matter***

10. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

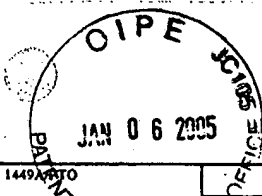
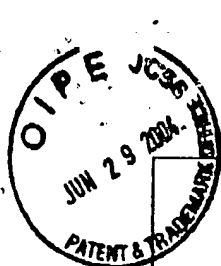
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



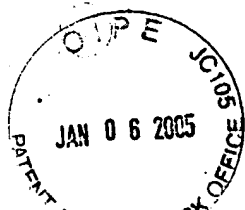
Charanjit S. Aulakh  
Primary Examiner  
Art Unit 1625



Substitute for form 1449A-PTO				Complete if Known			
INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Application Number			
(Use several sheets if necessary)				Filing Date			
				First Name Inventor			
				Group Art Unit			
				Examiner Name			
				Attorney Docket Number			
Sheet	1	of	2	20856 US2			
U.S. PATENT DOCUMENTS							
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited document MM-DD-YYYY		
		Number	Kind Code <sup>2</sup> (if known)				
CA	A1	3,701,780		Merck & Co., Inc.	10/31/1972		
CA	A2	6,596,731		Mutel, et al.	07/2003		
FOREIGN PATENT DOCUMENTS							
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	T <sup>4</sup>
		Office <sup>3</sup>	Number <sup>3</sup>	Kind Code <sup>3</sup> (if known)			
CA	B1	CH	590 862		Ciba Geigy AG	08/31/1977	
CA	B2	EP	050 563		Synthelabo	04/28/1982	
CA	B3	EP	092 458		Synthelabo	10/26/1983	
CA	B4	EP	092 459		Synthelabo	10/26/1983	
CA	B5	EP	172 096		Synthelabo	02/19/1986	
CA	B6	EP	185 345		Dr. Karl Thomae GmbH	06/25/1986	
CA	B7	EP	234 970		Synthelabo	09/02/1987	
CA	B8	EP	251 859		Synthelabo	01/07/1988	
CA	B9	EP	267 111		Synthelabo	05/11/1988	
CA	B10	FR	2 581 646		Synthelabo	11/14/1986	
CA	B11	JP	11-116481		Sumitomo Seiyaku KK	04/27/1999	
CA	B12	JP	50-140477		Yoshitomi Pharm Ind KK	11/11/1975	
CA	B13	JP	51-004194		Yoshitomi Pharm Ind KK	01/14/1976	
CA	B14	JP	51-125095		Yoshitomi Pharm Ind KK	11/01/1976	
CA	B15	WO	98/39342		Metabasis Therapeutics, Inc.	09/11/1998	
CA	B16	WO	00/08021		Quimica Sintetica, S.A.	02/17/2000	
CA	B17	WO	01/74815		Ortho McNeil	10/11/2001	
CA	B18	WO	91/19497		SmithKline Beecham Corp.	12/26/1991	
Examiner Signature		Date Considered				ALAKH	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Unique citation designation number. <sup>2</sup>See attached Kinds of U.S. Patent Documents. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation or abstract is attached.



<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use several sheets if necessary)		<b>Complete if Known</b>			
		Application Number	10/809,068		
		Filing Date	March 25, 2004		
		First Name Inventor	Mutel, et al.		
		Group Art Unit	1625		
		Examiner Name	Aulakh, C.		
Sheet	2	of	2	Attorney Docket Number	20856 US2

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
CA	C1	SCHLAEGER et al., Cytotechnology, 30, pgs. 71-83 (1999)	
CA	C2	MÖHLER et al., Nature, 294, pgs. 763-765 (1981)	
CA	C3	KATRITZKY et al., J. Org. Chem., 65, pgs. 9201-9205 (2000)	
CA	C4	SUNDBER et al., J. Heterocyclic Chem., 25, pgs. 129-137 (1988)	
CA	C5	ANDREANI et al., Eur. J. Med. Chem., 29, pgs. 339-342 (1994)	
CA	C6	HABERMANN et al., J. Chem. Soc., Perkin Trans. 1, pgs. 2425-2427 (1999)	
CA	C7	ARBILLA et al., Eur. J. Pharmacol., 130, pgs. 257-263 (1986)	
CA	C8	MARUYAMA et al., Arzneim.-Forsch, 31(7), pgs. 1111-1118 (1981)	
CA	C9	CRESTANI et al., Br. J. Pharmacol, 131, pgs. 1251-1254 (2000)	
CA	C10	BUU-HOÏ et al., J. Org. Chem., 19, pgs. 1370-1374 (1954)	
CA	C11	BUU-HOÏ et al., Recl. Trav. Chim. Pays-Bas, 68, pgs. 441-472 (1949)	
CA	C12	MÖHLER et al., J. Neurochemistry, 37, pgs. 714-722 (1981)	
CA	C13	TOMODA et al., Bull. Chem. Soc. Jpn., 72, pgs. 1327-1334 (1999)	
CA	C14	LOISEAU et al., Eur. J. Med. Chem, 22, pgs. 457-462 (1987)	
CA	C15	KEMPTER et al., J. Prakt. Chem, 313, pgs. 977-985 (1971)	
CA	C16	PENTIMALLI et al., Boll. Sci. Fac. Chim. Ind. Bologna, 24, pgs. 205-214 (1966)	
CA	C17	KHIM-FARM Zh., 4, pgs. 20-26 (1970)	
CA	C18	BARLIN, Gordon B., Journal of Heterocyclic Chemistry, 35(5), pgs. 1205-1217 (1998)	
CA	C19	ALMIRANTE, Luigi et al., J. Med. Chem., 8(3), pgs. 305-312 (1965)	
Examiner Signature	AULAKH		DATE CONSIDERED

<sup>1</sup>EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>2</sup>Unique citation designation number. <sup>3</sup>Applicant is to place a check mark here if English language Translation or abstract is attached.

143261



<b>Notice of References Cited</b>	Application/Control No. 10/809,068	Applicant(s)/Patent Under Reexamination MUTEL ET AL.	
	Examiner Charanjit S. Aulakh	Art Unit 1625	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	IN-179790	12-1997	India	Raj, K. et al.	A61K 39/90
	O	IN-179788	12-1997	India	Raj, K. et al.	A61K 31/44RN
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.